

ESTTA Tracking number: **ESTTA168588**

Filing date: **10/15/2007**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	76657862
Applicant	Rotary International
Applied for Mark	RI
Correspondence Address	P. JAY HINES BAKER & HOSTETLER LLP 1050 CONNECTICUT AVE, NW WASHINGTON, DC 20036 UNITED STATES
Submission	Applicant's Request to Extend
Attachments	Extension Request.pdf (3 pages)(856795 bytes)
Filer's Name	P. Jay Hines
Filer's e-mail	tm-dc@cantorcolburn.com
Signature	/pjh/
Date	10/15/2007

UNITED STATES TRADEMARK PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL & APPEAL BOARD

.....
In re ROTARY INTERNATIONAL
.....

)
)
)
)
)
)
)

Application No.: 76/657,862

REQUEST FOR EXTENSION OF TIME TO FILE APPEAL BRIEF

Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

Dear Sir or Madam:

Applicant, Rotary International, by and through its undersigned counsel, hereby requests a sixty (60) day extension of time in which to file its brief on appeal in this case.

As grounds in support of this request for extension of time, Applicant asserts that additional time is needed to confer with the Examining Attorney in this case per his invitation in his denial of Applicant's Request for Reconsideration. In the Examining Attorney's denial of Applicant's Request for Reconsideration, the Examining Attorney states "if Applicant would like to address this issue via telephone, or has questions about its application, please telephone the assigned trademark examining attorney directly at the number below." Applicant's counsel has now received instructions from Applicant to attempt to work with the Examining Attorney to come up with an acceptable recitation of services. There are two phrases within the initial recitation of services that remain at issue with the Examining Attorney.

First, the Examining Attorney will not accept the phrase "**club services, namely, organizing, supervising and guiding the formation of clubs for philanthropic, humanitarian, service and educational purposes.**" Applicant wishes to call to the

Examining Attorney's attention the fact that this language has been accepted by the USPTO and allowed in seven other companion marks registered by Applicant. Specifically, this language was accepted in Registration Nos. 2,389,358; 2,302,027; 2,332,109; 2,313,600; 2,338,184; 2,329,109; and 2,303,790 owned by Applicant. Thus, in an effort to promote consistent decisions among companion applications pursuant to TMEP 702.03(a)(i), Applicant's counsel is attempting to speak with the Examining Attorney to gain his approval of this phrase as used in the recitation of services.

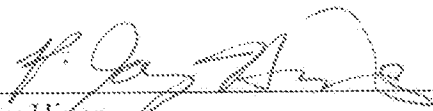
Second, the other phrase in the initial recitation of services that is still at issue with the Examining Attorney is "**online information services relating to education and entertainment.**" The Examining Attorney initially objected to this language and asked that it be amended to "**providing online information in the field of education and entertainment, namely, _____**" in his May 26, 2006 office action. In Applicant's response to the office action filed on November 22, 2006, Applicant sought to amend this phrase to "**providing online education and entertainment information in the field of philanthropic, humanitarian and service activities.**" On January 9, 2007, the Examining Attorney issued a second and final office action refusing the amended phrase presented by Applicant in its November 22, 2006 office action response. The Examining Attorney refused the amended language because it considered the amendment to require classification in another class, other than International Class 41. The Examining Attorney had requested Applicant to specify the fields of its "providing online information in the field of education and entertainment" services, yet when Applicant provided the fields, then the Examining Attorney said that those fields pulled that portion of the recitation of services into other classes. Thus, Applicant is still left trying to come up with a field description that is acceptable to the Examining Attorney without requiring classification in another class. Applicant's counsel wishes to speak with the Examining Attorney regarding a proposed resolution to this matter before continuing with the appeal as such efforts may go a long way in resolving this impasse without the need to take up the time and resources of the Board.

As this is Applicant's first request for an extension of time to file its appeal brief and because Applicant believes there is good cause for granting an extension of time

under the circumstances, Applicant believes the extension request is well taken and respectfully requests favorable action.

Respectfully submitted,
ROTARY INTERNATIONAL

October 15, 2007


P. Jay Hines
Rebecca L. Roby
Cantor Colburn LLP
1800 Diagonal Road
Suite 510
Alexandria, VA 22314
Tel.: (703) 236-4509
Fax: (703) 236-4501
tm-de@cantorcolburn.com
Attorneys for Applicant